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REMARKS**Rejection under 35 U.S.C. § 112, First Paragraph**

Claims 1, 13 "and related claims" stand rejected under 35 U.S.C. § 112, first paragraph for alleged lack of enablement. 6/23/05 Office Action, page 2, second paragraph.

The rejection apparently relates to the olefin-alkyl (meth)acrylate copolymers of claims 1 and 13. Claim 1 as filed recited the term "olefin-alkyl (meth)acrylate copolymer." In their 4/26/05 Amendment, Applicants amended claim 1 to add the limitation that the olefin-alkyl (meth)acrylate copolymer "is the polymerization product of (a) an olefin selected from ethylene and C₃-C₈ α-olefins, and (b) an alkyl (meth)acrylate, wherein the alkyl group is selected from methyl, propyl, n-butyl, n-pentyl, n-hexyl, n-heptyl, n-octyl." Claim 13 as filed included the limitation that "the olefin-alkyl (meth)acrylate copolymer is selected from the group consisting of ethylene-methyl acrylate copolymer, ethylene-ethyl acrylate copolymer, ethylene-methyl methacrylate copolymer, and ethylene-ethyl methacrylate copolymer." In their 4/26/05 Amendment, "ethylene-ethyl acrylate copolymer" was deleted from the Markush group. In the present office action, the Examiner states,

Claims 1, 13 and related claims are rejected under 35 U.S.C. 112, first paragraph, because the specification, while enabling for the alkyl group is C1-C8 alkyl, does not reasonably provide enablement for the deletion of a ethyl group which is C2 alkyl. The specification does not enable any person skilled in the art to which it pertains, or with this it is most nearly connected to make and/or use the invention commensurate in scope with these claims.

The deletion of said ethyl group in the (b) component, an alkyl (meth)acrylate raise new issues that would require further consideration and search.

6/23/05 Office Action, page 2, second and third paragraphs.

Applicants respectfully traverse this rejection. First, Applicants respectfully request clarification of the meaning of "related claims" in the rejection of "Claims 1, 13

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and related claims." For the purposes of this response, Applicants assume that "related claims" refers to pending claims that depend from claim 1 or claim 13, i.e., to claims 2-8, 10, 11, and 14-26.

Second, Applicants respectfully assert that the Examiner has not satisfied the Office's burden of making a prima facie case for lack of enablement. "The first paragraph of 35 U.S.C. § 112 requires that the specification of a patent must enable a person skilled in the art to make and use the claimed invention." *In re Wands*, 858 F.2d 731, 735 (Fed. Cir. 1992). However, "a patent need not disclose what is well known in the art." *Id.* "When rejecting a claim under the enablement requirement of section 112, the PTO bears an initial burden of setting forth a reasonable explanation as to why it believes that the scope of protection provided by that claim is not adequately enabled by the description of the invention provided in the specification of the application; this includes, of course, providing sufficient reasons for doubting any assertions in the specification as to the scope of enablement." *In re Wright*, 999 F.2d 1557, 1561-1562 (Fed. Cir. 1993).

Here, the Examiner expressly concedes that the specification is "enabling for [olefin-alkyl (meth)acrylate copolymers in which] the alkyl group is C1-C8 alkyl." If the specification is enabled for all olefin-(C₁-C₈)-alkyl (meth)acrylate copolymers, it is, *a fortiori*, enabled for any subset of olefin-(C₁-C₈)-alkyl (meth)acrylate copolymers (e.g., for copolymers of "(a) an olefin selected from ethylene and C₃-C₈ α-olefins, and (b) an alkyl (meth)acrylate, wherein the alkyl group is selected from methyl, propyl, n-butyl, n-pentyl, n-hexyl, n-heptyl, n-octyl" as in amended claim 1, and for "olefin-alkyl (meth)acrylate copolymer is selected from the group consisting of ethylene-methyl acrylate copolymer, ethylene-methyl methacrylate copolymer, and ethylene-ethyl methacrylate copolymer" as in amended claim 13). The Examiner has not provided any reasonable explanation for why claims 1 and 13 are not enabled by the specification. The Examiner makes two statements, neither of which constitutes a reasonable explanation for lack of enablement. The Examiner first states that the specification "does not reasonably provide enablement for the deletion of a ethyl group which is C2 alkyl." 6/23/05 Office Action, page 2, second paragraph. Applicants are puzzled by this

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statement, which is inconsistent with the statement in the same sentence that the specification is "enabling for the alkyl group is C1-C8 alkyl." *Id.* Candidly, Applicants wonder whether the Examiner's concern relates not to enablement but to the written description requirement of 35 U.S.C. § 112, first paragraph. If that is the case, reference to claim 12 and paragraph [0024] of the application as filed should allay any concern. The Examiner then states that "deletion of said ethyl group in the (b) component, an alkyl (meth)acrylate raise new issues that would require further consideration and search." 6/23/05 Office Action, page 2, third paragraph. This statement simply has no bearing on the issue of enablement. In any case, the amendments to claims 1 and 13 were made in response to a first (i.e., non-final) office action, and Applicants are entitled to reconsideration and examination of the amended claims, even if the amendment raises new issues that require further consideration and searching. *See* MPEP 714, section I; 35 C.F.R. § 1.112.

For all of the above reasons, the Examiner has failed to establish a *prima facie* case for lack of enablement of claims 1 and 13 "and related claims." Accordingly, Applicants respectfully request the reconsideration and withdrawal of the rejection of claims 1, 13, "and related claims" as not enabled under 35 U.S.C. § 112, first paragraph.

Claim Rejections Under 35 U.S.C. § 102(b) or § 103(a)

Claims 1-8, 10, 11, 13-26, and 29-32 stand rejected under 35 U.S.C. § 102(a), as allegedly anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over U.S. Patent Application Publication No. 2002/0169256 of Merfeld et al. ("Merfeld"). 6/23/05 Office Action, page 2, fourth paragraph. Applicants respectfully traverse this rejection.

The Examiner has not substantively responded to Applicants' arguments in their 4/26/05 Amendment traversing the rejection of claims 1-26 and 29-32 under 35 U.S.C. § 102(a) or 103(a) over Merfeld. "Where the applicant traverses any rejection, the examiner should, if he or she repeats the rejection, take note of the applicant's argument and answer the substance of it." MPEP 707.07(f). Although the Examiner states that Applicants' 4/26/05 Amendment "does not overcome the rejection made in the last Office

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action," and further states that "[t]he rejection is maintained for the reasons as stated above and for the reasons as stated in the last Office action," the 6/23/05 Office Action provides no substantive response to and rebuttal of Applicants' arguments in their 4/26/05 Amendment. 6/23/05 Office Action, page 2, first through fourth paragraphs. For example, the Examiner has not responded to Applicants' argument that Merfeld does not teach the olefin-alkyl (meth)acrylate copolymers of the rejected claims. To the extent that the Examiner argues that the amendments to claims 1 and 13 "raise new issues that would require further consideration and search," he appears to concede that Merfeld is not an adequate basis for the rejection. 6/23/05 Office Action, page 2, third paragraph.

Accordingly, Applicants respectfully request the reconsideration and withdrawal of the rejection of claims 1-8, 10, 11, 13-26, and 29-32 as anticipated by or obvious over Merfeld based on the arguments made in Applicants' 4/26/05 Amendment. For the convenience of the Examiner, the substance of those arguments is reiterated below.

Merfeld generally describes a curable composition comprising a functionalized poly(arylene ether), an alkenyl aromatic monomer, an acryloyl monomer, and a polymeric additive having a glass transition temperature less than or equal to 100° C and a Young's modulus less than or equal to 1000 megapascals at 25° C. Merfeld abstract. The only olefin-alkyl (meth)acrylate copolymer mentioned by Merfeld is "ethylene-ethyl acrylate[]" copolymer in paragraph [0084].

Applicants' claims 1-8, 10, 11, 13-26, and 29-32 are not anticipated by Merfeld because Merfeld does not teach the olefin-alkyl (meth)acrylate copolymers required by those claims. Anticipation requires that all of the elements of the claim be found within a single prior art reference. *Scripps Clinic & Research Foundation v. Genentech, Inc.*, 927 F.2d 1565, 1576 (Fed. Cir. 1991). Establishing a prima facie case of obviousness requires that all limitations of the claim be taught or suggested by the prior art. *See, e.g., CFMT, Inc. v. Yieldup Intern. Corp.*, 349 F.3d 1333, 1342 (Fed. Cir. 2003); *In re Royka*, 490 F.2d 981, 985 (C.C.P.A. 1974). Applicants' independent claims 1, 29, and 30 were amended in their 4/26/05 Amendment to recite olefin-alkyl (meth)acrylate copolymers that do not read on Merfeld's ethylene-ethyl acrylate copolymer. Merfeld thus fails to

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teach the olefin-alkyl (meth)acrylate copolymer recited in each of claims 1, 29, and 30. Accordingly, Merfeld cannot anticipate these claims or support a prima facie case of obviousness against them. Because claims 2-8, 10, 11, and 13-26 each depend ultimately from and further limit claim 1, and because claims 31 and 32 incorporate by reference the compositions of claims 1 and 29, respectively, claims 1-8, 10, 11, 13-26, and 29-32 are patentable over Merfeld. Applicants therefore respectfully request the reconsideration and withdrawal of the rejection of claims 1-8, 10, 11, 13-26, and 29-32 under 35 U.S.C. § 102(a) or § 103(a) over Merfeld.

Other Rejections from the 2/24/05 Office Action

The Examiner having made no mention in the 6/23/05 Office Action of the 2/24/05 Office Action's rejection over U.S. Patent No. 3,665,058 to Snodgrass et al. and rejection over U.S. Patent No. 6,352,782 to Yeager et al., Applicants assume that these rejections have been withdrawn.

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It is believed that the foregoing amendments and remarks fully comply with the Office Action and that the claims herein should now be allowable to Applicants. Accordingly, reconsideration and allowance is requested.

If there are any additional charges with respect to this Amendment or otherwise, please charge them to Deposit Account No. 06-1130 maintained by Assignee.

Respectfully submitted,

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